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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,510	01/06/2004	Robert W. Jones	14991.01	3347

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EXAMINER

DRODGE, JOSEPH W

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,510

Applicant(s)

JONES, ROBERT W.

Examiner

Joseph W. Drodge

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453-O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1723

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12,16 and 17 remain rejected under 35 U.S.C. 102(e) as being anticipated by Pourdeyhimi et al PGPUBS Document US2005/0034376, published 2/17/05 and filed 09/23/2003. Pourdeyhimi et al disclose a foam filter insert, of open cell foam material combined with a gutter having all of the cross-sectional features of filter insert and gutter of the instant claims, including the angled or triangular side between front edge of outer portion of upper side and lower side that is forward of rear edge of lower side, so as to generally correspond to the generally triangular shape of outer surface of the cooresponding gutter while leaving some void space between filter insert and lower and outer sides of the gutter (see especially figure 1B and paragraphs 20,53, 69 and 71.

As to the added limitation of a substantially triangular-shaped void being defined between angled side and gutter bottom and front wall, such void is clearly shown in figure 1B of Pourdeyhimi et al.

As to claim 16, figure 1B also shows the gutter inner lip portion extending downward and inward that may bear against the filter insert depending upon how the material is cut prior to fitting into the gutter (paragraph 69).

Art Unit: 1723

For claim 17, figure 1B also illustrates the gutter and filter insert being located below the draining eave of a roof.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pourdeyhimi et al in view of Dugan patent 3,855,132 of record.

Claim 13 differs in requiring foam material to have 10 to 20 cells per square inch, a limitation taught by Dugan at column 2, lines 36-38. It would have been obvious to have utilized such open cell parameter of Dugan with the foam insert of Pourdeyhimi, so as to assure adequate water flow through the foam without allowing significant contaminant flow therethrough.

Claims 15 and 19 differ in requiring foam sections of four feet in length, Pourdeyhimi broadly stating that the insert can be cut prior to insertion (paragraph 21). Dugan teaches a gutter filter insert with such lengths of foam at column 2, lines 27-34.

Art Unit: 1723

It would have also been obvious to one of ordinary skill in the art to have manufactured the foam of Pourdeyhimi et al as approximate four foot sections, as taught by Dugan to facilitate ready insertion and removal for cleaning of the foam.

For claim 20, Pourdeyhimi et al also disclose the filter insert being readily placed or fitted into the gutter, hence also removable from the gutter (paragraphs 20 and 21).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pourdeyhimi et al in view of Dugan as applied to claim 13 above, and further in view of Etani patent 3,946,362 of record. Claim 14 specifies polyether foam, Dugan teaching polyurethane foam and Etani teaching that polyether foam is a component of polyurethane foam filters. It would have been obvious to have utilized polyether or polyurethane foam for the filter insert of Pourdeyhimi et al, in view of Dugan and Etani, since these materials are readily available and easily manufactured and processed.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Poureyhimi et al in view of Dugan as applied to claim 17 above, and further in view of Hunt patent 5,103,601 of record. Claim 18 differs in requiring gutter spikes extending through the gutter upper lip to secure gutter to building structure. It would have been further obvious to one of ordinary skill in the art to have utilized the spikes of Hunt in the installation of gutter and insert of Pourdeyhimi, in order to firmly secure gutter to building so that it does not fall off.

The Declaration filed on September 9, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Pourdeyhimi et al reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Pourdeyghi et al reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The submitted evidence is not sufficiently commensurate with the claims to demonstrate conception.

Firstly, the provisional Patent Application, consists of a single drawing and a one sentence specification, consisting simply of a plastic foam insert completely filling a gutter, with no evidence of the claimed interaction with a gutter to have an angled side or any form of void between foam and gutter. It is noted that there is no official record in the PALM patent application tracking system linking the provisional application to the instant application 10/751,510.

Secondly, it is unclear whether the January 30, 2002 invoice was directed towards the simple foam insert of the provisional Patent Application or to the more detailed filter insert device referred to in the disclosure submitted to the Littman Law Offices on March 19, 2003.

Finally, while the drawing and one page description constituting the March 19, 2003 submission to Littman Law Office are more closely related to the invention as now claimed, they also do not sufficiently show either the claimed feature of a filter insert extending between lower point of lower side of gutter and gutter front wall upper lip and

Art Unit: 1723

especially do not show a substantially triangular shaped void defined between angled filter insert side and gutter front and bottom walls, as recited in the instant claims.

Claims 12,13,15-17,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan patent 3,855,132 in view of Beechert et al patent 5,242,591, both of record. Dugan discloses a foam filter insert 2, of open cell foam material (Abstract and column 2, lines 21-26), combined with a gutter 5 having all of the cross-sectional features of filter insert and gutter of the instant claims, including angled or triangular sides 7 between front edge of outer portion of upper side and lower side that is forward of rear edge of lower side, so as to generally correspond to the generally triangular shape of outer surface of the corresponding gutter while leaving some void space between filter insert and lower and outer sides of the gutter (see especially figure 1 and column 1, lines 56-60).

The claims firstly differ in requiring the insert to have an angled side extending between lower point of lower gutter wall and gutter front wall upper lip. Beechert et al teach such angled side of a polyurethane filter foam insert 20 against an angled gutter wall side 36 of a gutter. It would have been obvious to one of ordinary skill in the art to have manufactured the filter insert of Dugan to contain such angled side taught by Beechert et al, in order to better fit the insert into gutters having an angled outer wall, gutters conventionally having such angled outer wall to facilitate their stability against environmental forces of angled heavy rains and wind damage and ease of installation requirements against the side of houses.

The claims also differ from Dugan in requiring a substantially triangular-shaped void being defined between angled side and gutter bottom and front wall. However, Dugan discloses, a void, formed by a slot or with support spacers 7 to allow increased water flow between bottom of foam filter insert and gutter walls is shown in figure 1 and described in column 2, lines 9-21. Beechert et al teach small voids of a triangular shape formed between side and bottom walls of gutter and filter insert. It would have been further obvious to one of ordinary skill to have manufactured the filter foam insert of Dugan to contain such triangular shaped void as taught by Beechert, in order to allow easier insertion and removal of the insert into the gutter walls when the gutter walls themselves have a triangular shaped side.

As to claim 16, figure 1 also shows a gutter inner lip portion extending downward and then inward

For claim 17, figure 1 also illustrates the gutter and filter insert being located below the draining eave of 4 of a roof.

Regarding claim 13, requiring foam material to have 10 to 20 cells per square inch, such limitation is taught by Dugan at column 2, lines 36-38.

Regarding claims 15 and 19, Dugan teaches a gutter filter insert with four foot lengths of foam at column 2, lines 27-34.

For claim 20, Dugan also discloses the filter insert being readily placed or fitted into the trough of gutter walls (column 1, lines 56-60 and 26-28, hence also removable from the gutter

Art Unit: 1723

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Etani patent 3,946,362 of record. Claim 14 specifies polyether foam, Dugan teaching polyurethane foam and Etani teaching that polyether foam is a component of polyurethane foam filters. It would have been obvious to have utilized polyether or polyurethane foam for the filter insert of Dugan, as taught by Etani, since these materials are readily available and easily manufactured and processed.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Hunt patent 5,103,601 of record. Claim 18 differs in requiring gutter spikes extending through the gutter upper lip to secure gutter to building structure. It would have been further obvious to one of ordinary skill in the art to have utilized the spikes of Hunt in the installation of gutter and insert of Dugan, in order to firmly secure gutter to building so that it does not fall off.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1723

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant's arguments filed on September 9, 2005 have been fully considered but they are not persuasive. It is argued that Pourdeyhimi et al does not disclose a substantially triangular-shaped void defined between angled side, front wall and bottom wall of gutter, since the reference discloses substantially filling the space of the roof gutter. However, Pourdeyhimi et al also discloses in his summary of invention at paragraph 20, invention object of achieving optimal flow rates and continuous flow of water through a gutter. In paragraph 20 and elsewhere in the specification, the reference discloses objects of forming a product that can be easily inserted into modern gutter designs, and can also be easily manufactured, modern gutter designs featuring outwardly angled outer walls with curved sections that would necessarily leave drainage voids against a basically triangular shaped outward wall of a filter insert that does not have the complex curved sections of the outer gutter wall.

Art Unit: 1723

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

September 24, 2005

Joseph Drodge
JOSEPH DRODGE
PRIMARY EXAMINER